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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,619	01/23/2001	Ursula Murschall	00/052 MFE	3096

7590

09/03/2003

ProPat, L.L.C.
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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,619

Applicant(s)

MURSCALL ET AL.

Examiner

Lawrence D Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 10 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 8, 9, 11 and 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed April 30, 2003. Claims 1 and 15 were amended and claim 16 was added rendering claims 1-11 and 14-16 pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goss et al (U.S. 5,935,903) in view of Murschall et al. (U.S. 5,900,294).

Goss discloses a thermoplastic polymeric film (column 1, lines 10-12 and column 9, lines 65-66) where the film is formed of polyester material, where a polyethylene terephthalate film is preferred (column 2, lines 30-47). Goss discloses the film comprises titanium dioxide pigments (column 4, lines 28-36) where the filler material is added by masterbatch technology (column 6, lines 1-13). The reference discloses the film comprising an optical brightener in an amount of from 50 to 1000 ppm (column 6, lines 14-27) and where the titanium dioxide is in an amount of 5% weight or less (column 4, lines 29-50). Goss discloses the thickness of the film will not exceed 250 μ m (column 6, lines 49-51). Figures 2-3 of Goss portray a core and outer layer, as indicated

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in instant claim 10. As to limitation in claim 1, 'a crystallizable polyolefin-free thermoplastic polyester polymer' constitutes a 'capable of' limitation. Such a recitation that an element is 'capable of' performing a function is not a positive limitation, but only requires the ability to so perform. In instant claim 7, 'where the particle size is determined using a Sedigraph method) is a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Goss does not disclose a rutile type titanium dioxide oxidatively coated as in instant claim 1. Murschall teaches a multilayer film comprising white pigments of rutile titanium dioxide with a coating of zinc oxide (column 3, lines 47-65). Goss and Murschall are analogous art because they are both from the same field of multilayered films. It would have been obvious to one of ordinary skill in the art to use the zinc oxide coating on a rutile titanium dioxide pigment because Murschall teaches this oxidized coating of titanium improves lightfastness (column 3, lines 47-56).

4. Claims 5-6, 8-9, 11 and 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. The rejection of claims 1-5 under 35 USC 112, second paragraph has been overcome due to Applicant's amendment of claim 15 so that it is no longer dependent from claim 14, but rather from claim 10.

Applicant's remarks to rejection under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (U.S. 5,660,931) in view of Murschall et al. (U.S. 5,900,294) has been considered but is rendered moot based on grounds of new rejection.

Applicant's remarks to rejection under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (U.S. 5,660,931) in view of von Meer (U.S. 4,384,040) further in view of Murschall et al. (U.S. 5,900,294) has been withdrawn due to Applicant's amendment to claim 6 and arguments.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

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The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774



ELIZABETH MULVANEY
PRIMARY EXAMINER